



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,766	09/10/2003	Kenichi Watanabe	1247-0520P	4081
2292 7590 08/02/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER MOUZON, LAJUANIA N	
			ART UNIT 2153	PAPER NUMBER
			NOTIFICATION DATE 08/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/658,766

Applicant(s)

WATANABE, KENICHI

Examiner

La Juania N. Mouzon

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 3/18/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

3. Claim 4 is objected to because of the following informalities: pg. 61 line 8 should read, "...at least either of the apparatus body **and** or the..."

Appropriate correction is required.

4. Claim 5 is objected to because of the following informalities: pg. 61 line 1, should read, "The ~~the~~ communication apparatus..."

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2153

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-2, 4-6, and 8-13 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kenmochi et al. (US 5,487,106) in view of Kubosono et al.

(JP8084197).

8. In regards to claim 1 Kenmochi et al. discloses, a communication apparatus

connectable to the Internet comprising **(Col. 2 line(s) 18-31, teaches a facsimile**

apparatus (an apparatus body) with a modem being connectable to the Internet.):

- a. an apparatus body including connecting means for connecting the communication apparatus to the Internet **(Col. 2 line(s) 18-31, teaches a facsimile apparatus (an apparatus body) with a modem as means for being able connect to the Internet.);**

- b. and a storage device capable of being detachably attached to the apparatus body, or portable as a unit from the apparatus body **(Col. 2 line(s) 4-**

18, teaches the storage device (the card) as being connected and detachable (portable) from the apparatus body.);

c. the storage device being capable of storing at least either of information being a subject for communications and setting information necessary for the Internet connection, as information on the Internet (**Col. 2 line(s) 5-13, teaches the card as having RAM which is capable of storing at least either of information being a subject for communications and setting information necessary for the Internet connection, as information on the Internet.), and including:**

- i. display means for displaying stored information (**Col. 3 line(s) 42-48, teaches display means for displaying stored information.);**
- ii. and input means for subjecting the information displayed on the display means, to an editing manipulation (**Col. 3 line(s) 33-35, teaches the keyboard as being input means for subjecting the information displayed on the display means, to an editing manipulation.),**

9. Kenmochi et al. do not teach the connection means of the apparatus body performing communications through the Internet utilizing the information on the Internet as stored in the storage device.

10. In the same field of endeavor Kubosono et al. teach a communication network as connection means, from the apparatus body, that uses the information from the information card (storage device) to connect to the internet (**¶0012**).

11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenmochi et al. communication apparatus capable of utilizing portable device with Kubosono et al. teaching as discussed above to allow for the capability of using the information communication link card to choose the optimal communication network for direction of a user automatically, and can communicate to offer the efficient communication mode which can communicate without being conscious of the information communication network and communication service to diversify.

12. In regards to claim 2 Kenmochi et al. discloses, wherein the apparatus body further includes setting means for setting the information on the Internet as stored in the storage device, to be valid or invalid **(Col. 2 line(s) 56-60, teaches varies manipulation keys, as define in the specification on pg. 50 line(s) 6-9, for setting means for setting the information on the Internet as stored in the storage device, to be valid or invalid.)**.

13. In regards to claim 4 Kenmochi et al. discloses, a communication apparatus connectable to the Internet **(Col. 2 line(s) 18-31, teaches a facsimile apparatus (an apparatus body) with a modem being connectable to the Internet.)**, comprising:

- d. a separate unit which is separable from an apparatus body, and which is connectable so as to operate in association with the apparatus body **(Col. 2 line(s) 4-18, teaches a portable card (separate unit) that is separable from**

the facsimile apparatus and which is connectable so as to operate in association with the apparatus body.),

e. the separate unit including storage means capable of storing at least either of information being a subject for communications and setting information necessary for the Internet connection, as information on the Internet **(Col. 2 line(s) 5-13, teaches the card as having RAM which is capable of storing at least either of information being a subject for communications and setting information necessary for the Internet connection, as information on the Internet.);**

14. Kenmochi et al. do not teach at least either of the apparatus body and the separate unit includes connection means for performing the communications through the Internet, utilizing the information on the Internet as stored in the storage means of the separate unit.

15. In the same field of endeavor Kubosono et al. teach a communication network as connection means, from the apparatus body, that uses the information from the information card (storage device) to connect to the internet **(¶0012).**

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenmochi et al. communication apparatus capable of utilizing portable device with Kubosono et al. teaching as discussed above to allow for the capability of using the information communication link card to choose the

optimal communication network for direction of a user automatically, and can communicate to offer the efficient communication mode which can communicate without being conscious of the information communication network and communication service to diversify.

17. In regards to claim 5 Kenmochi et al. discloses, a storage device capable of being detachably attached to the apparatus body, or portable as a unit from the apparatus body **(Col. 2 line(s) 4-18, teaches the storage device (the card) as being connected and detachable (portable) from the apparatus body.);**

f. the storage device being capable of storing at least either of information being a subject for communications and setting information necessary for the Internet connection, as information on the Internet **(Col. 2 line(s) 5-13, teaches the card as having RAM which is capable of storing at least either of information being a subject for communications and setting information necessary for the Internet connection, as information on the Internet.),** and including:

iii. display means for displaying stored information **(Col. 3 line(s) 42-48, teaches display means for displaying stored information.);**

iv. and input means for subjecting the information displayed on the display means, to an editing manipulation **(Col. 3 line(s) 33-35, teaches the keyboard as being input means for subjecting the information displayed on the display means, to an editing manipulation.);**

18. Kenmochi et al. do not teach the connection means of the apparatus body performing communications through the Internet utilizing the information on the Internet as stored in the storage device.

19. In the same field of endeavor Kubosono et al. teach a communication network as connection means, from the apparatus body, that uses the information from the information card (storage device) to connect to the internet (**¶0012**).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenmochi et al. communication apparatus capable of utilizing portable device with Kubosono et al. teaching as discussed above to allow for the capability of using the information communication link card to choose the optimal communication network for direction of a user automatically, and can communicate to offer the efficient communication mode which can communicate without being conscious of the information communication network and communication service to diversify.

21. In regards to claim 6 Kenmochi et al. discloses, wherein the apparatus body further includes setting means for setting the information on the Internet as stored in the separate unit or the storage device, to be valid or invalid (**Col. 2 line(s) 56-60, teaches varies manipulation keys, as define in the specification on pg. 50 line(s) 6-9, for setting means for setting the information on the Internet as stored in the storage device, to be valid or invalid.**).

22. In regards to claim 8 Kenmochi et al. do not teach, wherein in the case where the information on the Internet as stored in the separate unit and the information on the Internet as stored in the storage device are both set valid by the setting means, and where only either of the separate unit and the storage device is connected or attached, the connection means performs the communications through the Internet by utilizing the information on the Internet as stored in either of them.

23. In the same field of endeavor Kubosono et al teach wherein in the case where the information on the Internet as stored in the separate unit and the information on the Internet as stored in the storage device are both set valid by the setting means, and where only either of the separate unit and the storage device is connected or attached, the connection means performs the communications through the Internet by utilizing the information on the Internet as stored in either of them (**¶0012**).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenmochi et al. communication apparatus capable of utilizing portable device with Kubosono et al. teaching as discussed above to allow for the capability of using the information communication link card to choose the optimal communication network for direction of a user automatically, and can communicate to offer the efficient communication mode which can communicate without being conscious of the information communication network and communication service to diversify.

Art Unit: 2153

25. In regards to claim 9 Kenmochi et al. do not teach, wherein in the case where the information on the Internet as stored in the separate unit and the information on the Internet as stored in the storage device are both set valid by the setting means, and where the separate unit is connected, while the storage device is attached, the connection means performs the communications through the Internet by utilizing the information on the Internet as stored in that one of the separate unit and the storage device whose priority level is higher in accordance with preset priority levels.

26. In the same field of endeavor Kubosono et al teach wherein in the case where the information on the Internet as stored in the separate unit and the information on the Internet as stored in the storage device are both set valid by the setting means, and where the separate unit is connected, while the storage device is attached, the connection means performs the communications through the Internet by utilizing the information on the Internet as stored in that one of the separate unit and the storage device whose priority level is higher in accordance with preset priority levels (**¶0012**).

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenmochi et al. communication apparatus capable of utilizing portable device with Kubosono et al. teaching as discussed above to allow for the capability of using the information communication link card to choose the optimal communication network for direction of a user automatically, and can communicate to offer the efficient communication mode which can communicate without

being conscious of the information communication network and communication service to diversify.

28. In regards to claim 10 Kenmochi et al. discloses, wherein the separate unit is a manipulation panel which can be detachably attached to the apparatus body (**Col. 2 line(s) 4-18, teaches the separate unit (the card) as being a manipulation panel connected and detachable (portable) from the apparatus body.**),

g. and with which a manipulating input for a communication function is possible in both an attached state and a detached state (**Col. 2 line(s) 4-13 and 22-31, teaches that a manipulating input for a communication function is possible in both an attached state and a detached state.**) .

29. In regards to claim 11 Kenmochi et al. discloses, wherein the separate unit is a slave set which can operate with the apparatus body being a master set (**abstract, teaches that the card is a slave set which can operate with the apparatus body being a master set.**).

30. In regards to claim 12 Kenmochi et al. discloses, a program which causes a computer to function as any of the communication apparatus of claim 1 (**Col. 2 line(s) 25-27, teaches the communication apparatus (facsimile apparatus) having ROM in which is programs to control the facsimile apparatus as claimed in claim 1.**).

31. In regards to claim 13 Kenmochi et al. discloses, program which causes a computer to function as any of the communication apparatus of claim 4 (**Col. 2 line(s)**

25-27, teaches the communication apparatus (facsimile apparatus) having ROM in which is programs to control the facsimile apparatus as claimed in claim 4.).

32. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenmochi et al. (US 5,487,106), further in view of Kubosono et al. (JP8084197) as applied to claim 1 above, and further in view of Sato et al. (US 5,384,834).

33. In regards to claim 3 neither Kenmochi et al. nor Kubosono et al. teach, wherein the apparatus body further includes warning means responsive to a set content of the setting means and an attached state of the storage device; the warning means issues a warning for notifying that no storage device is attached, in the case where the information on the Internet is set valid by the setting means and where the storage device is not attached, and issues a warning for prompting the user to designate which of a plurality of storage devices is to be validated, in the case where the plurality of storage devices are attached; and the warning means issues a warning for notifying that the storage device is invalidated, in the case where the information on the Internet is set invalid by the setting means and where the storage device is attached.

34. In the same field of endeavor Sato e al. teach wherein the apparatus body further includes warning means responsive to a set content of the setting means and an attached state of the storage device (**Col. 10 line(s) 49-68 – Col. 11 line(s) 1-13**); the warning means issues a warning for notifying that no storage device is attached (**Col. 11 line(s) 36-40**), in the case where the information on the Internet is set valid by the

setting means and where the storage device is not attached, and issues a warning for prompting the user to designate which of a plurality of storage devices is to be validated, in the case where the plurality of storage devices are attached (**Col. 11 line(s) 43-45**); and the warning means issues a warning for notifying that the storage device is invalidated, in the case where the information on the Internet is set invalid by the setting means and where the storage device is attached (**Col. 10 line(s) 49-68 – Col. 11 line(s) 1-13**).

35. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenmochi et al. communication apparatus capable of utilizing portable device and Kubosono et al. information communication card system with Sato et al. teaching as discussed above to allow for the capability of sending messages representing when the correct settings are not detected when the detachable memory device is attached or not.

36. In regards to claim 7 neither Kenmochi et al. nor Kubosono et al. teach, wherein the apparatus body further includes warning means responsive to a set content of the setting means and an attached state of the storage device; the warning means issues a warning for notifying that no storage device is attached, in the case where the information on the Internet is set valid by the setting means and where the storage device is not attached, and issues a warning for prompting the user to designate which of a plurality of storage devices is to be validated, in the case where the plurality of

storage devices are attached; and the warning means issues a warning for notifying that the storage device is invalidated, in the case where the information on the Internet is set invalid by the setting means and where the storage device is attached.

37. In the same field of endeavor Sato et al. teach wherein the apparatus body further includes warning means responsive to a set content of the setting means and an attached state of the storage device (**Col. 10 line(s) 49-68 – Col. 11 line(s) 1-13**); the warning means issues a warning for notifying that no storage device is attached (**Col. 11 line(s) 36-40**), in the case where the information on the Internet is set valid by the setting means and where the storage device is not attached, and issues a warning for prompting the user to designate which of a plurality of storage devices is to be validated, in the case where the plurality of storage devices are attached (**Col. 11 line(s) 43-45**); and the warning means issues a warning for notifying that the storage device is invalidated, in the case where the information on the Internet is set invalid by the setting means and where the storage device is attached (**Col. 10 line(s) 49-68 – Col. 11 line(s) 1-13**).

38. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenmochi et al. communication apparatus capable of utilizing portable device and Kubosono et al. information communication card system with Sato et al. teaching as discussed above to allow for the capability of sending messages representing when the correct settings are not detected when the detachable memory device is attached or not.

Conclusion


39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Benton et al. (US 4,625,276) data logging and transfer system using portable and resident units.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to La Juania N. Mouzon whose telephone number is 571-270-3045. The examiner can normally be reached on Monday - Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LNLM


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100